No. 18-302

In The
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR RESPONDENT

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QUESTIONS PRESENTED

1. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

2. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is unconstitutionally vague under the First and Fifth Amendments.

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CONSTITUTIONAL PROVISIONS

"Congress shall make no law . . . abridging the freedom of speech. . . ." Constitution, First Amendment.

"No person shall be . . . deprived of life, liberty, or property, without due process of law;. . . ." Constitution, Fifth Amendment.

STATUTORY PROVISION

"No trademark . . . shall be refused registration . . . unless it—

(a) Consists of or comprises immoral . . . or scandalous matter;. . . ."

Lanham Act, Section 2(a), 15 U.S.C. § 1052(a).

STATEMENT

In a facial challenge, the facts in the specific case are often irrelevant. But here, Brunetti's application demonstrates the negative impact of the Immoral and Scandalous Clauses ("Clauses") on free speech.

1. Brunetti is an artist. J.A. 60. He founded the FUCT brand in 1990. J.A. 38. The name of the brand is pronounced as four letters, one after another.[1]

[1] It is not expected that it will be necessary to refer to vulgar terms during argument. If it should be necessary, the discussion

Brunetti's brand focuses on questioning authority: the assumptions of society, the government, and accepted wisdom. Pet. App. 57a. Brunetti's brand comments on current political and societal issues, sometimes obviously, and sometimes subtly. J.A. 60. To the extent FUCT has a meaning, it is FRIENDS U CAN'T TRUST. J.A. 38.

Since 1991, his products have been distributed throughout America. *Id.* His products have never been sold at general retailers such as Walmart or Target. During the pendency of this matter, Brunetti has stopped selling to brick-and-mortar stores and now sells only on the internet.

2. The application in question was filed in 2011. J.A. 8. The United States Patent and Trademark Office ("PTO") examining attorney reviewed the application and issued two separate office actions and considered the responses. An Amendment to Allege Use, after another office action was issued and responded, was accepted on May 20, 2012. J.A. 35. The examining attorney approved the mark for publication. The law office managing attorney did not raise the vulgarity of the FUCT mark. J.A. 34-36. Publication review was completed on June 11, 2012, without any immoral or scandalous objection. J.A. 32. It was only afterwards that some PTO official, whose name has been concealed from the record, decided to withdraw the

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will be purely clinical, analogous to when medical terms are discussed.

application from publication and return it to the examining attorney with instructions to refuse the application.

Thereafter the application was refused on the ground that FUCT is the phonetic equivalent of the word "fucked," the past tense form of the verb "fuck." J.A. 17-22; Pet. App. 56a. Ultimately, the application was finally refused. J.A. 25-31.

3. Brunetti appealed the refusal to the Trademark Trial and Appeal Board ("Board"). It issued its decision on August 1, 2014. The Board wrote:

> Erik Brunetti is an artist and entrepreneur whose graphics are infused with cultural strands from skateboarding, graffiti culture, punk rock music, and remnants of Situationist Ideal ideologies. He has been a trailblazer since the early nineties in popularizing "streetwear" having revolutionary themes, proudly subversive graphics and in-your-face imagery. His assaults on American culture critique capitalism, government, religion and pop culture. Brunetti's blog is directed to a cult following that he, his company, Fuct Manuf. Co., and Fuct's "Same Shit Different Day" line of clothing have developed since he allegedly first adopted this designation in 1991. Pet. App. 57a-58a.

The Board concluded that Brunetti's website and blog contained "anti-social imagery," was "lacking in taste," and contained a theme "of extreme nihilism." Pet. App. 63a-64a. "Applicant's cult following may well

represent a reliable niche market for its goods and ideology." Pet. App. 66a.

The Board discounted Brunetti's meaning of Friends U Can't Trust. The Board refused to give any weight to Brunetti's evidence that only one person in the history of the brand objected to his trademark. Pet. App. 66a.

The Board affirmed the refusal. Pet. App. 67a.

4. A timely appeal was filed to the Federal Circuit. While this case was pending, the Court of Appeals decided *In re Tam*, 808 F.3d 1321 (2015) (*en banc*), which overruled *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) and its progeny. (The Government's brief relies heavily on *McGinley* and its progeny, without mentioning that they have been overruled.) The Court of Appeals asked for further briefing on the impact of the *en banc* decision in *Tam*. The Government responded that "given the breadth of the Court's *Tam* decision and in view of the totality of the Court's reasoning," there was no reasonable basis for treating immoral or scandalous marks differently than disparaging marks. Gov't Letter Br. 2, *In re Brunetti*, No. 15-1109, Docket No. 52 (Fed. Cir. Jan. 21, 2016). The Government maintained, however, that if the Solicitor General sought Supreme Court review of the *en banc* decision in *Tam*, "the Government may argue that, under reasoning less sweeping than that adopted in *Tam*, the bar on registration of scandalous and immoral marks would survive even if the bar on registration of disparaging marks were held invalid." *Id.* at 4.

After this Court decided *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Court of Appeals requested further briefing on the impact of this Court's decision. Thereafter, this case was re-argued before the same panel. The Court of Appeals issued its decision on December 15, 2017. It held the Clauses facially unconstitutional because they targeted the expressive function of trademarks and therefore strict scrutiny applied. The Government conceded the Clauses did not survive strict scrutiny. Pet. App. 31a. The Court of Appeals held, alternatively, that even if the Clauses regulated purely commercial speech, they did not survive intermediate scrutiny because the Government had no substantial interest that was served by the Clauses. Pet. App. 41a-42a. Brunetti argues that the Court of Appeals' decision was correct and should be affirmed by this Court.

The Court of Appeals did not apply *Marks v. United States*, 430 U.S. 188 (1977) analysis to this Court's decision in *Tam*. Rather it relied on the unanimous portions of *Tam*, and on those principles which Justices Alito and Kennedy agreed. The Court of Appeals did not find it necessary to decide whether its *en banc* decision in *In re Tam* was binding because the Court of Appeals independently resolved such issues, relying on *Tam* and other Supreme Court decisions. Pet. App. 18a n.1.

5. In the Court of Appeals and in its Petition, the Government failed to discuss many of Brunetti's arguments (e.g., refusal of registration under the Clauses is always due to viewpoint, profanity expresses viewpoint, the PTO refuses only some profanity, and the

Clauses are not readily susceptible of being read in the manner the Government contends). Accordingly, in his Brief in Response to Petition, Brunetti wrote that "the Government hopefully will address these arguments in its opening brief on the merits. . . ." However, the Government mostly ignored these critical points.

SUMMARY OF ARGUMENT

The Court of Appeals should be affirmed.

The Immoral and Scandalous Clauses of Section 2(a) prohibit registration of trademarks involving politics, religion, social issues, ethnicity, the role of women, drugs, violence, humor, double entendres, slang, patriotism, profanity, and excretory and sexual references. Any mark that is likely to offend some part of the public is to be refused. The Government wisely chooses not to defend the plain language of the Clauses because such language is clearly unconstitutional.

Below, and in its petition, the Government focused on defending the Clauses as allegedly content-neutral so long as the Clauses are interpreted as applying only to profanity, excretory, and sexual matters (hereinafter "PES marks"). Brunetti pointed out that the Clauses are not readily susceptible of such interpretation. Additionally, the PTO allows some PES marks and refuses others, so it is not applying the Clauses in a content-neutral manner, but rather based upon the perceived offensiveness of the marks and the applicant's intended meaning. The Government also

assumes that profanity does not express a viewpoint. Profanity usually expresses a viewpoint: at minimum, of non-compliance with societal mores. But Brunetti's mark, as the Board found, was offensive *because* he "critique[d] capitalism, government, religion and pop culture." Pet. App. 57a.

In its merits brief, the Government further narrows its interpretation of the Clauses to apply only to sexual activity/imagery/organs, although it occasionally refers to profanity. The Clauses are not readily susceptible to that construction. The Government conflates obscenity, which can be refused, with vulgarity. The Government implicitly argues that it can prohibit speech relating to sexual matters without such speech actually being obscene.

There is no principled reason to reach a different result here than this Court reached as to the Disparagement Clause in *Matal v. Tam*, 137 S. Ct. 1744 (2017). Trademarks are refused because they are offensive.

In deciding this case, if the Court determines that marks refused under the Immoral/Scandalous Clauses do not express viewpoint, then the Court should confirm that the appropriate level of scrutiny for content regulation is strict scrutiny. The Government's reasons for a lesser level of or no scrutiny should be rejected. If trademark registration is not government association, forum, program, speech, or subsidy for disparaging trademarks, then trademark registration cannot be so for immoral or scandalous marks. Although some of

these contentions were not explicitly rejected in *Tam*, all lack merit.

And if even the Court does not reach the vagueness of the Clauses, such vagueness informs whether the Clauses are unconstitutionally overbroad.

In order to determine the extent to which *Tam* is a binding precedent, the Court must decide the many unanswered questions about how the *Marks* Rule applies. *Marks v. United States*, 430 U.S. 188, 194 (1977). Brunetti suggests the Court should return to the common law rule of Dual Majority: majority on the judgment and majority on the reasoning.

ARGUMENT

I. THE IMMORAL/SCANDALOUS CLAUSES ARE FACIALLY INVALID

The *Tam* Court was unanimous that giving offense is a viewpoint. Trademarks are refused under the Immoral/Scandalous Clauses solely due to offensiveness. Therefore, the Clauses discriminate on viewpoint and strict scrutiny applies.

The Government seeks to distinguish *Tam* by advancing a novel interpretation of the Clauses: that they are merely content-regulation (of either profanity, excretory and sexual matter) or of sexual activity/imagery/organs. That is not how the Clauses have been interpreted for seventy years. But even if the Clauses

were only content-regulation, this would still be subject to strict scrutiny under *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015).

Even if intermediate scrutiny under *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980), were appropriate, the Clauses do not survive such scrutiny.

The other position advanced by the Government is that the "mode of expression" (i.e., profanity) can be regulated. The Government's reliance on *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), is misplaced.

A. The Immoral/Scandalous Clauses Regulate Viewpoint.

The Court was unanimous that giving offense is a viewpoint.

> Giving offense is a viewpoint. We have said time and again that "the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers." *Tam*, 137 S. Ct. at 1763 (Alito, J., plurality).

Justice Kennedy cited to Justice Alito's opinion, quoted immediately above, and wrote:

> [T]he Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed. *Tam*, 137 S. Ct. at 1767.

Since the Government seems to question the applicability of *Tam*, it should be noted the Court's prior decisions, such as *Street v. New York*, 394 U.S. 576, 592 (1969), and *Texas v. Johnson*, 491 U.S. 397, 409-10 (1989), reach the same conclusion.

1. Brunetti's Mark Was Refused Because It Was Offensive.

The record is clear that Brunetti's mark was refused due to its offensiveness. The Board wrote:

> Whether one considers "fucked" as a sexual term, or finds that Applicant has used "fucked/fuct" in the context of extreme misogyny, nihilism or violence, we have no question but that these are still extremely offensive terms in the year 2014. Pet. App. 65a.
>
> We find that the Trademark Examining Attorney has shown by a preponderance of the evidence that a substantial composite of the general public would find this designation vulgar. Pet. App. 66a.

2. Refusals Under the Immoral/Scandalous Clauses Are Always Based Upon the Degree of Offensiveness.

a. The Test for Refusal Is Offensiveness.

A mark is refused if "it would be considered offensive by a substantial portion of the public." *Trademark Manual of Examining Procedure* ("TMEP") § 1203.01,

quoting *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996).

b. The Government Is Regulating Offensiveness.

The Government allows *some* profanity, excretory, and sexual content and refuses *some*. So it is not engaging in a content-neutral regulation of PES marks. Rather, the basis for deciding whether to approve an application is *degree of the perceived offensiveness* of the mark.

Actual practice shows that the Government allows registration of some profanity. For example, it always allows "damn." Sometimes it allows "ass," "cock," "dick," "pussy."[2] *See* Appendix. The Government even allows marks that are "fuck," provided they are misspelled or not spelled out (FCUK (Reg. 2920270); FWORD (75/590854); and WTF IS UP WITH MY LOVE LIFE?! (Reg. 4024774)).

As to excretory words, the Government allows "feces," "poop," "turd," (FAMOUS FECES, 78/315509); POOP (Reg. 2956358); and TURD TOTER (BECAUSE NOBODY WANTS TO SEE YOUR TURD) (Reg. 5397982), even though their meaning is identical to

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[2] The Government refused PUSSY RIOT (87/152598) pending the Court's decision here. Pussy Riot is a musical group fighting for freedom and human rights in Russia, and has been repeatedly mentioned on the American nightly news without causing a scandal. Yet the Government contents the mark is too offensive to be registered.

"shit." The Government also allows "piss" and "urine." (SATAN'S PISS (Reg. 5233724) and URINE OFF (Reg. 2553449)).

The Government approves some sexual terms, for example, "pink taco" (when referring to female genitalia, e.g., PINK TACO FAN CLUB, 77/402098, refused for other reasons), "foreplay," "intercourse" (as in IRISH BY INTERCOURSE (Reg. 4136786)), 69 (when referring to sexual activity as in MILE HIGH 69 (87/718907) and LOOPY SEX GAME 18+ OH 69 (Reg. 5583858)). Although the Government claims it has a content-neutral prohibition of profanity, excretory, and sexual marks, that clearly is not true.

3. Immoral/Scandalous Refusals Are Based Upon Viewpoint.

a. Profanity Expresses Viewpoint.

The Government argues that profanity does not express viewpoint. That is contrary to the unanimous holding of *Tam* that giving offense is viewpoint.

At minimum, use of profanity expresses nonconformance to conventional social mores.

Justice Harlan's reasoning in *Cohen v. California*, 403 U.S. 15 (1971), rejects the contention that profanity does not express viewpoint:

> "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached

> explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which, practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.* at 26.

The Government seeks to distinguish *Cohen* on the basis that the "conviction rested on 'the asserted offensiveness of the *words*.'" Govt. Br. 29. That is no distinction: in both *Cohen* and here, the Government is prohibiting a word (virtually the identical word). As *Cohen* held, words are protected speech. "Thus, we deal here with a conviction resting solely upon 'speech'. . . ." *Cohen*, 403 U.S. at 18.[3]

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[3] Justice Harlan wrote:

> How is one to distinguish this ["fuck"] from any other offensive word? Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. Yet no readily ascertainable general principle exists for stopping short of that result were we to affirm the judgment below. For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen v. California*, 403 U.S. at 26.

No one who hears George Carlin's *Filthy Words* (often referred to as *Seven Words You Can Never Say on Television*), the subject of *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), can doubt that profanity does express viewpoint. "The words of the Carlin monologue are unquestionably 'speech' within the meaning of the First Amendment." 438 U.S. at 744, 746 (Stevens, J., plurality) (no justice expressed doubt that Carlin's monologue expressed viewpoint).

b. The PTO Inquires into the Applicant's Meaning When Deciding Whether a Mark Is Offensive.

The Government often explicitly considers the applicant's meaning. *See In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1341 (Fed. Cir. 2003) ("it is clear that the marks as used by Boulevard in connection with the services described in Boulevard's application refer to masturbation" and "the applicant's use of the word is clearly limited to the vulgar meaning of the word"); *see In re Hershey*, 6 U.S.P.Q.2d 1470, 1470 (TTAB 1988) (BIG PECKER BRAND not scandalous because of how used).

Compare refused marks: SPECIALIZING IN CELEBRITY HAND JOBS, for manicure services; pedicure services, (85/823860 (refused)), and HANDJOB (77/671044 (refused)) ("the applicant argues that the mark is not immoral or scandalous because it is a play on words suggestive of the services performed by the applicant. This argument, however, is not persuasive

because the term 'hand job' does not have a non-vulgar meaning").

With approved marks: HANDJOB NAILS AND SPA (Reg. 4944424), for day spa services, namely, nail care, manicures, pedicures; BUBBLES CAR WASH BETTER THAN A HAND JOB (86/683666), for car wash (refused only due to likelihood of confusion; examining attorney even referred to the double entendre).

And compare refused mark FAT COCK BEER (85/253332) with approved mark I BRAKE FOR COCK! (Reg. 5677097).

Because the PTO routinely inquires into the applicant's intended meaning before deciding whether a mark is immoral/scandalous, it is unambiguously regulating viewpoint.[4]

c. Immoral/Scandalous Clause Refusals Are Always Based Upon Viewpoint.

On an even broader level, Immoral/Scandalous Clause refusals are always based upon the Government's opinion that the expressed viewpoint is offensive. Marks favorable to religion are allowed, but

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[4] What would happen if a registered mark (such as I BRAKE FOR COCK) is transferred to a new owner who has a different meaning or the registrant had a different meaning)? Does the mark become vulgar? It would seem so. And if so, that means that the registrant's intended meaning is decisive, not the words by themselves. In short, not content-neutral.

marks critical of religion or likely to cause religious controversy are prohibited. Marks that are cheerful and positive (e.g., Smiley Face) are granted, while viewpoints that are negative or controversial (e.g., middle finger-shaped bottle design) are refused. Marks about input into the digestive system are approved, while marks about output are rejected. Polite humor is fine, raunchy humor is scandalous. Raising babies is sweet, making babies is disgusting. Kissing is fine, sex is dirty. Feminism is good, misogyny is bad. The word PENIS is allowed, an outline of a penis is not. Promotion of capitalism is okay, criticism of capitalism is scandalous. *See* marks listed in J.A. 71-75. In all these situations, the Government is preferring certain viewpoints over other, disfavored viewpoints.

B. There Is No "Mode of Expression" Exception to Viewpoint Regulation.

The Government asserts that the Free Speech Clause only protects ideas and not "mode" of expression. It argues that the Immoral/Scandalous Clauses are viewpoint-neutral because, it contends, it is only regulating the "mode of expressing whatever idea the speaker wishes to convey." Govt. Br. at 9, 20, and 27, citing *R.A.V. v. City of St. Paul*, 505 U.S. 377, 393 (1992). This illustrates the danger of an isolated quote. *R.A.V.* involved conduct (cross-burning), not words.

The Government's reliance on a quote from *Cohen* is equally misplaced. Justice Harlan did refer to Cohen's language as a "distasteful mode of expression."

Id. at 21. But the Court held such expression to be protected speech. The Government correctly notes Justice Harlan's distinction between the emotive force of the vulgarity of Cohen's expression from the cognitive force of Cohen's idea. However, contrary to the Government's contention that only the idea is protected, Justice Harlan concluded that both the idea and the mode of expression were protected.

Finally, the Government relies on the plurality (Parts IV-A and IV-B) of *Pacifica*. The Government reads *Pacifica* to say that the offensiveness of expression is grounds to deny Free Speech protection. Justice Stevens wrote in footnote 18 that a "requirement that indecent language be avoided will have its primary effect on the form, rather than the content, of serious communication. There are few, if any, thoughts that cannot be expressed by the use of less offensive language." However, only three justices joined that part of the opinion, and a majority of justices in *Pacifica* did not accept Justice Stevens' views. In any event, *Pacifica* is a time/place/manner case that did not prohibit Carlin's monologue at other times of the day, or in other settings. *Pacifica* is also unique due to the invasiveness of radio and the fact that the airwaves are public property. The Court emphasized the extreme narrowness of its decision.

The Government's reading of Justice Stevens' plurality is contrary to both Justices Alito's and Kennedy's conclusions in *Tam*, that giving offense is viewpoint, as discussed above.

Even under Justice Steven's reasoning, it is difficult to see how Carlin could critique society's views of profanity without using the bad words. A law professor could do that, but undoubtedly the audience would soon stop listening. Carlin's language was intertwined with his message. And if Stevens' view were correct, then Cohen's conviction would have been upheld because he had an alternative mode of expression: PHEWY ON THE DRAFT would have conveyed the same cognitive idea without the profanity. The PTO could also return to refusing disparaging marks because there are other "modes" for Tam to express his pride in his heritage, such as WE ARE PROUD ASIAN-AMERICANS. Brunetti will have to change FRIENDS U CAN'T TRUST to BSOO—BE SKEPTICAL OF OTHERS. In none of these situations is the message exactly the same, i.e., the viewpoint is altered. Nor is there the same force, of which shock and offense plays a role. Nothing in the Free Speech case law suggests that the Government is entitled to force speakers to use bland language. Rather, the Government is claiming the right to require the trademark owners to change their marks or forego the valuable benefits of registration. That violates the First Amendment's prohibition on "governmental control over the content of messages expressed by private individuals." *Turner Broadcasting Sys., Inc. v. FCC*, 512 U.S. 622, 641 (1994). Nor is there anything in the Lanham Act that gives the Government the right to edit trademarks.

The Government cites a law review article that says that trademarks cannot be viewpoint unless they

communicate an "opposable view." There is nothing in this Court's Free Speech jurisprudence that supports such contention and the Government cites none. To the contrary, *Cohen*, *supra*, *Papish v. Board of Curators, Univ. of Missouri*, 410 U.S. 667 (1973); *Hess v. Indiana*, 414 U.S. 105 (1973); and *Lewis v. City of New Orleans*, 415 U.S. 130 (1974), are examples of profanity being protected when it was just profanity.

Is it possible that a brand owner could use profanity as a trademark without any viewpoint? Given the *Tam* holding that giving offense is viewpoint, probably not. But in any event, the record in this case shows that Brunetti has a viewpoint.

C. The Government Conceded that the Clauses Regulate Content. Strict Scrutiny Accordingly Is Required.

Assuming the Clauses are readily susceptible of being limited to PES marks or sexual organs, and further assuming that such limitation were viewpoint neutral, the Government is still regulating content. The Government restricts speech based on content when "a law applies to particular speech because of the topic discussed or the idea or message expressed." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015). To be content neutral the regulation must be "applicable to all speech irrespective of content." *Consolidated Edison Co. v. Public Svc. Comm'n*, 447 U.S. 530, 536 (1980).

The Government acknowledges it is regulating content. Govt. Br. at 25 (claiming that "content-based

distinctions are an inherent and inescapable part of the Lanham Act"). Also, "[t]he government concedes that § 2(a)'s bar on registering immoral or scandalous marks is a content-based restriction on speech. Oral Arg. at 11:57-12:05." Pet. App. 15a.

It follows that, if the Clauses are content-regulation, strict scrutiny is still required by *Reed*, 135 S. Ct. at 2227. Accordingly, Brunetti urges the Court to apply strict scrutiny and hold the Immoral/Scandalous Clauses facially unconstitutional.

D. The Immoral/Scandalous Clauses Do Not Survive Any Level of Scrutiny.

Brunetti contends that *Reed* implicitly overruled or limited *Central Hudson* as to "content-based regulations of speech" because *Reed* applied strict scrutiny to such regulations. *Reed* stated:

> In light of this underinclusiveness, the Town has not met its burden to prove that its Sign Code is narrowly tailored to further a compelling government interest. Because a "law cannot be regarded as protecting an interest of the highest order, and thus as justifying a restriction on truthful speech, when it leaves appreciable damage to that supposedly vital interest unprohibited," the Sign Code fails strict scrutiny. *Reed*, 135 S. Ct. at 2232 (citation omitted).

At minimum, *Reed* implicitly limited *Central Hudson* to purely commercial transactions, such as offers to sell.

However, if the Court determines that intermediate scrutiny is the appropriate level, the Clauses are still unconstitutional.

> Under *Central Hudson*, a restriction of speech must serve "a substantial interest," and it must be "narrowly drawn." This means, among other things, that "[t]he regulatory technique may extend only as far as the interest it serves." *Tam*, 137 S. Ct. at 1764 (Alito, J.) (plurality) (citations omitted, quoting *Central Hudson* at 564-65).

The plurality in *Turner, supra,* required that, in the First Amendment context, Congress must draw reasonable inferences based on substantial evidence. "[W]hen trenching on first amendment interests, even incidentally, the government must be able to adduce either empirical support or at least sound reasoning on behalf of its measures." 512 U.S. at 666 (Kennedy, J., plurality) (citation omitted). Here, the Government advances neither empirical support nor sound reasoning.

Below, the Government struggled to find any substantial interest. The Government referred to "protecting public order and morality." Gov't Letter Br. 15 & n.6, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017). Now, the Government rephrases that as the "government's legitimate interest in protecting the sensibilities of the public." Govt. Br. 32. However,

> the government's general interest in protecting the public from marks it deems "offputting," whether to protect the general public or the government itself, is not a substantial interest justifying broad suppression of speech. "[T]he fact that society may find speech offensive is not a sufficient reason for suppressing it." *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983) ("At least where obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression.") Pet. App. 34a.

The Government does not have a substantial interest in promoting trademarks it "has deemed to be most suitable" (Pet. App. 33a), or "trademarks that are appropriate for all audiences, including children." (Govt. Br. 33). If it did have such interest, then the Government has spectacularly failed in the trademark context. *See Brief of* Amicus Curiae *Pro-Football, Inc.*, in *Tam*, and its appendix with 18 pages of offensive marks that the Government has registered. Even if offensive trademarks are registered, that will not turn the clock back to the days of *My Three Sons*.

The Government also refers to the orderly flow of commerce. Govt. Br. 33-34. The Government offers no support for its claim that the refused marks are less capable of source-identification or make commercial transactions less efficient. "[T]he government has failed to articulate how this interest is in any way advanced by the immoral or scandalous prohibition, or

how that provision is narrowly tailored to that interest." Pet. App. 32a n.4. Nor is there any factual basis: no FedEx pilots have refused to fly because Brunetti's products were on board, no mall has been closed because Brunetti's products were offered there. Customers are able to distinguish FUCT products from NIKE products.

Offense to UPTO examining attorneys is not a substantial government interest because the examiners have to view the trademarks in order to refuse or approve them.

Preventing government association (Govt. Br. 34) does not have a factual basis and is not a substantial government interest. *See* Part III-C. The Government's argument that trademarks are "inherently commercial in nature" (Govt. Br. 36) is not a government interest.

Even if there were some substantial governmental interest, the Immoral/Scandalous Clauses are not narrowly drawn. Nor are the Clauses likely to advance the alleged interest because, as the Government argues elsewhere, the trademark owners can use their trademarks in any event (it is just that such use is unconstitutionally burdened). Finally, less restrictive means exist, such as requiring a disclaimer on registration certificates, or imposing login and age verification to view offensive marks on the PTO website.

The Immoral/Scandalous Clauses cannot survive any applicable level of scrutiny.

II. THE IMMORAL/SCANDALOUS CLAUSES ARE NOT SUBJECT TO REDUCED SCRUTINY

The Government advances a number of argument leases why the Immoral/Scandalous Clauses are subject to lesser scrutiny under the Free Speech Clause. All of these were implicitly rejected by the Court in *Tam*, otherwise, the Court would not have invalidated the Disparagement Clause.

A. Trademark Registration Is a Registration System.

The PTO never asserted prior to *Tam* that trademark registration was government speech, government association, government program, government subsidy, or a government-created forum. The reason is that none of those concepts are applicable to federal trademark registrations.

Although it sounds like a tautology, trademark registration is a system of registration. It confers legal recognition and rights.

> [A] registered trademark redefines the nature of the markholder's rights as against the rights of other citizens, depriving others of their ability to use the mark. Like the programs in *Bullfrog* and *Texas Lottery Commission*, the system of trademark registration is a regulatory regime, not a government subsidy program. *In re Tam*, 808 F.3d 1321, 1353 (Fed. Cir. 2015).

The Principal and Supplemental Registers, created by the Lanham Act, are databases created to list the holders of rights.[5]

The Government has many other databases: non-profit organizations (Tax Exempt Organization Search, Internal Revenue Service), names of vessels (National Vessel Documentation Center, U.S. Coast Guard), motor carriers names (Unified Registration System, Federal Motor Carrier Safety Administration), names of drugs (Drugs@FDA Data Files, Food & Drug Administration), and names of businesses approved for Government contracts (System for Award Management, Department of Transportation).

It is preposterous to contend that government registration converts the name of every vessel, non-profit, drug, and contractor into something that the Government may prohibit with minimal constitutional scrutiny.

B. The Lanham Act Does Not Create a Forum.

The Government claims the Court of Appeals erred in failing to consider cases involving forums. Govt. Br. 41.

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[5] The Court of Appeals noted that "[a]part from its function as a database, the government has been unable to define exactly what the principal register is, or where it is located." Pet. App. 28a.

Forums are places "for expressive activity." *Perry Ed. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45 (1983). In contrast, the Principal and Supplemental Registers are not forums for discussion. Rather they are databases of trademarks that meet the statutory criteria and paid the required fee. Analogously, the records of the Copyright Office constitute a database, not a forum.

The Court of Appeals is correct:

> "The government fails to articulate a reason why the government's listing of registered trademarks in a database creates a limited public forum. And if it did then every government registration program including titles to land, registration of cars, registration of wills or estates, copyrights, even marriage licenses could similarly implicate a limited public forum. We thus conclude that government registration of trademarks does not create a limited public forum in which the government can more freely restrict speech." Pet. App. 28a.

C. Government Association Is Not a Basis for Lesser Scrutiny.

The Government claims it has a "legitimate interest in avoiding any appearance that the government approves such marks." Govt. Br. 34. It claims that "the public may still perceive that association [federal registration and specifically ®] as evidence of government approval. . . ." *Id.* at 35.

This is a weakened version of the government speech argument unanimously rejected in *Tam*. Private speech cannot be converted into government speech "by simply affixing a government seal of approval." *Tam*, 137 S. Ct. at 1758. "[T]here is no evidence that the public associates the contents of trademarks with the Federal Government." *Id.*

> The PTO has made it clear that registration does not constitute approval of a mark. "[I]ssuance of a trademark registration . . . is not a government imprimatur." And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means. "The purchasing public knows no more about trademark registrations than a man walking down the street in a strange city knows about legal title to the land and buildings he passes." *Tam*, 137 S. Ct. at 1759 (Alito, J.) (citations omitted).

If ® equates to government approval, then virtually the entire American economy is "approved" by the Government because most products (including books, magazines, newspapers, and movies) bear registered trademarks. And, if the Government were correct, all copyrighted works bearing © are perceived by the public as Government approved.

Furthermore, the Government could easily avoid the alleged association by including a disclaimer. Notably, after *Tam*, the Government did not bother to add a disclaimer to Tam's registration certificate.

D. Trademark Registration Is Not a Government Subsidy.

The Government contends that the Clauses are entitled to relaxed Free Speech scrutiny because it asserts that trademark registration is a government subsidy.

There is nothing in the legislative history of the Lanham Act suggesting that Congress intended the trademark registration system to subsidize trademarks. And, since 1991, the PTO has been self-supported by user fees. *In re Tam*, 808 F.3d at 1353.

Justice Alito explicitly rejected the subsidy argument, saying "no difficult question is presented here." *Tam*, 137 S. Ct. at 1761 (plurality). Trademark registration does not involve "cash subsidies or their equivalent." *Id.* The Government is not spending money at all, except possibly incidentally. *See also In re Tam*, 808 F.3d at 1351 ("the subsidy cases have all involved government funding or government property.").

The Government reads Justice Kennedy's opinion as limiting the rejection of the subsidy contention only to viewpoint discrimination. Although he prefaces his discussion with a reference to viewpoint discrimination, that is not relevant to whether registration is a government subsidy. Either the entire system of trademark registration is a subsidy for all marks (both those with viewpoint and those without) or it is not. Justice Kennedy wrote that the subsidy issue "may turn on whether certain commercial concerns for the protections of trademarks might, as a general rule, be the

basis for the regulation." *Tam*, 137 S. Ct. at 1767 (Kennedy, J.). If preventing consumer confusion and protecting brand owners are the purposes of the Lanham Act (which they clearly are), as distinguished from a statute whose purpose is to subsidize favored speech, then trademark registration is not a government subsidy.

Is *Tam* a binding precedent on this issue? Which is narrowest, not a subsidy (Alito, J.) or not reaching the issue at all (Kennedy, J.)? *Marks* provides no answer. Brunetti contends that logically the subsidy issue, as a preliminary question, has to be decided before the level of scrutiny, since the latter assumes that there is no subsidy. If so, then Justice Alito's opinion is narrowest and the binding precedent on the subsidy issue.

If *Tam* did not decide the issue, then this Court should follow Justice Alito's opinion as persuasive.[6]

E. No Government Program Exception Applies.

The Government claims it only "imposes a condition on the availability of a government benefit." Govt.

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[6] Even if trademark registration were a government subsidy, the Government is seeking to improperly "leverage its power to award subsidies on the basis of subjective criteria into a penalty on disfavored viewpoints." *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 585, 587 (1998). *See also Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech").

Br. 20. The Government argues that the Court of Appeals ignored *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009), and *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007). The Court of Appeals had discussed these cases in *Tam*, 808 F.3d at 1351. However, the Government chose not to cite these cases in this case until its petition for a rehearing *en banc*, which was denied without opinion. So there was no reason for the Court of Appeals to discuss these cases or the Government's theory.

Besides, those cases involve "the unique context of public-sector agency-shop arrangements," where the Government, as employer, "act[s] in a capacity other than as regulator." *Davenport*, 551 U.S. at 188, 190.

The Government quotes Justice Alito on the point that governments may "confer a substantial non-cash benefit." 137 S. Ct. at 1762, *cited in* Govt. Br. 43. However, the Government ignores Part III-C of Justice Alito's plurality opinion, which correctly rejects the Government's "government program" theory. He wrote that these cases are "far removed from the registration of trademarks." *Tam*, 137 S. Ct. at 1762. He concluded, "*Davenport* and *Ysursa* are no more relevant for present purposes than the subsidy case previously discussed." *Id.*

Is Justice Alito's opinion a binding precedent under *Marks*? The analysis is the same as discussed above. And if Justice Alito's opinion is not a binding precedent, then his analysis should be followed.

F. The Immoral/Scandalous Clauses Do More Than "Deny Benefits of Federal Trademark Registration"; They Unconstitutionally Burden Speech.

The Government asserts that "the sole effect" of the Clauses is "to deny respondent the benefits of federal trademark registration" and that they do not ban any speech. Govt. Br. 19. The Government correctly asserts that denial of registration does not prohibit Brunetti from using his mark. But that misses the point.

The *Tam* Court recognized that "[f]ederal registration, however, 'confers important legal rights and benefits on trademark owners who register their marks.'" 137 S. Ct. at 1753. Part I-B of *Tam* listed many of the vitally important benefits granted by federal registration. Other important consequences of the denial of registration include the reluctance of law enforcement to take action against counterfeiters and the difficulty of obtaining the cooperation of online shopping platforms to remove counterfeits. *See, e.g., Brief of* Amicus Curiae *San Francisco Dykes on Bikes* in *Tam* at 3. The lack of a registration significantly impacts the ability to sell a brand (because there is no proof of ownership of the mark) or to obtain financing (because federal recordal of a security interest is not possible).

G. Commercial Speech Is No Exception to the Free Speech Clause.

The Government asserts that a "trademark is inherently commercial in nature, since its 'predominant function' is to identify a mark owner's company as the source of goods in commerce." Govt. Br. 36. The Government implies that removes the Immoral/Scandalous Clauses from Free Speech analysis.

The Government confuses "used in commerce" with "commercial speech." To be federally registered, trademarks have to be used in commerce regulated by Congress (with exceptions not relevant here). Many trademarks are non-commercial, such as those used by advocacy groups, churches, non-profits, and political groups. The Government then makes the further incorrect assumption that trademarks do not convey messages. That may have been true two hundred years ago when silversmiths used simple marks. But that is no longer true. As stated in Part I-A of Justice Alito's opinion (joined by all eight members): "[T]rademarks often consisted of catchy phrases that convey a message." *Tam*, 137 S. Ct. at 1752.[7] Today, trademarks are used for more than just commercial goods. They are used for blogs, charitable fundraising, entertainment services,

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[7] Justice Alito declined to decide whether "all trademarks are commercial speech" or "many, if not all, trademarks have an expressive component." 137 S. Ct. at 1764. He stated that "[w]e need not resolve this debate between the parties because the disparagement clause cannot withstand even *Central Hudson* review." *Id.* However, there is little doubt that the Court agreed that trademarks are expression. *See, e.g.*, 137 S. Ct. at 1759 n.10-14.

information services, posters, promoting public awareness, social networking, websites featuring views, etc.

It cannot be disputed that many trademarks convey messages. Some marks involve core speech about politics, religion, and society: ABORTION MUST END NOW; AMBULANCE CHASERS SUCK; BLACK LIVES MATTER TO ME; DEMOCRATS ARE THE PARTY OF WE REPUBLICANS ARE THE PARTY OF ME; GOD DOES NOT HAVE A PENIS; GUN CONTROL MY ASS. . . . ; LEGALIZE ACID; MAKE AMERICA GREAT AGAIN; PETA CRUELTY FREE; RELIGIOUS COALITION FOR ABORTION RIGHTS; THANK YOU FOR POT SMOKING, and countless more.

But even if the Government's contention had merit, purely commercial speech (such as that which merely proposes a business transaction) is entitled to at least intermediate scrutiny.

III. THE IMMORAL/SCANDALOUS CLAUSES ARE UNCONSTITUTIONALLY VAGUE

The Due Process Clause "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). There are two reasons:

> [F]irst, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory

> way. . . . When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech. *Id.*

"Vague laws force potential speakers to steer far wider of the unlawful zone . . . than if the boundaries of the forbidden areas were clearly marked." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 807 (2011) (Alito, J., concurring) (citation and internal quotation marks omitted).

Vague speech restrictions do not just chill speech, they cause discriminatory enforcement because a "vague law impermissibly delegates basic policy matters" to low-level decision-makers "for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application." *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972).

A. This Court Has for Good Reason Expressed Concern About the Vagueness of Section 2(a).

The *Tam* Court's concern about the vagueness of the Disparagement Clause applies equally here.

The PTO has acknowledged that the guidelines "for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one." 137 S. Ct. at 1756-57.

The PTO has similarly observed that whether a mark is disparaging "is highly subjective and, thus, general rules are difficult to postulate." *Id.* at n.5 (citation omitted). *See also Tam*, 808 F.3d at 1341-44. Footnote 6 discusses the recognition of this problem even in the hearings on what became the Lanham Act. *See especially* Judge O'Malley's concurring opinion.

B. The Government Cannot Agree What the Immoral/Scandalous Clauses Cover.

Attorneys from both the Departments of Commerce and Justice are on the briefs in this Court. If Commerce and Justice cannot agree on what the Immoral and Scandalous Clauses cover, obviously the general public is not given fair notice of what is prohibited.

1. Department of Commerce Interpretation: Vulgar, Lacking in Taste

The Department of Commerce (i.e., the PTO) asserts that *seven* categories of marks are refused under the Scandalous Clause:

> "*inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. The statutory language "scandalous" has also been considered to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude." TMEP § 1203.01 (2018) (citations omitted).

The case law adds *four* additional phrases:

> To be considered "scandalous," a mark must be "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; . . . *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

Additionally, immoral marks are refused under the Immoral Clause, although no one seems to know how immoral differs from scandalous. "Although the words 'immoral' and 'scandalous' may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter." TMEP § 1203.01 (2018).

Rather than providing clarity, this flood of definitions amplifies the uncertainty about what is prohibited.

2. Department of Justice Interpretation: Profanity, Excretory, Sexual.

The Department of Justice has a completely different interpretation of what is covered by the Scandalous Clause. In the Court of Appeals, the Government claimed the Clause was only content regulation because, supposedly, the Clause only prohibited profanity, excretory and sexual matter. Govt. Ltr. Brief, July 20, 2017 (Docket 60) at 7, 14.

In its merits brief, the Government chooses not to define "scandalous" at all, implicitly abandoning its PES construction. Instead, it inconsistently refers to

sexual activity, explicit imagery and sexual organs. To be fair, the Government does occasionally mention profanity and vulgar marks, but they are not the primary focus of the Government's arguments.

Brunetti agrees that obscene marks can be refused registration because they are subject to minimal or no First Amendment protection. Nor could such marks be legally used in commerce regulated by Congress.[8]

3. The Clauses Are Not Readily Susceptible to the Department of Justice's Interpretation.

The Government's proffered re-interpretations of the Clauses should not be adopted by this Court. "As always, our inquiry into the meaning of the statute's text ceases when 'the statutory language is unambiguous and the statutory scheme is coherent and consistent.'" *Tam*, 137 S. Ct. at 1748, quoting *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002). A court "may impose a limiting construction on a statute only

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[8] Brunetti's mark is not obscene, i.e., hardcore pornography. His mark does not appeal to the prurient interest. It does not depict or describe in an offensive way sexual conduct or excretory functions as specifically defined by law. (The Clauses do not specifically define anything). Brunetti contends that his brand (of which his mark is inextricably intertwined) conveys serious political and social commentary. None of the elements required by *Miller v. California*, 413 U.S. 15 (1973) are present. The Government seems to argue that Brunetti's mark, although not obscene, can be regulated as if it were. That would undercut *Miller*. It is difficult to see how a trademark could be obscene unless it is either a photograph or an explicit drawing.

if it is readily susceptible to such a construction." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 884 (1997) (citation and internal quotation marks omitted). The first time the Government suggested the PES construction was in 2017, after this Court's ruling in *Tam*. Obviously, if no one in seventy years thought the statute was so limited, it is not readily susceptible of being construed as only applying to PES marks.

If the Clauses apply only to sexual activities/explicit imagery/organs, they are even further removed from the statutory language. And, in any event, such interpretation is irrelevant because Brunetti's mark is not sexual activities/explicit imagery/organs.

C. The Clauses Are Inconsistently Applied.

The chart submitted in the Court of Appeals shows the PTO's contradictory and arbitrary application of the Clauses. *See* Appendix A to Letter Brief (Docket 70), filed August 9, 2017 (J.A. 71-75). *See also* Appendix to this brief. These appendices prove unconstitutional vagueness of the Clauses.

The Government defends its inconsistencies as occasional mistakes by an overworked agency. First, when there is a danger of chilling speech, that is no excuse. A vague law that regulates speech on the basis of message "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno, supra*, 521 U.S. at 871-72.

Second, while the PTO may handle 400,000 applications per year, it appears that the number of applications refused due to the Clauses have been a few dozen per year. *See* Megan M. Carpenter and Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENTER. L.J. 321, 322 (found 232 trademark applications were refused based upon the Clauses from 2001 to 2011; because of the limitations on searching the PTO database the actual number could be higher.) Even if the actual number is an order of magnitude greater, one examining attorney could handle all such applications (most handle several dozen applications per week) and could ensure consistency if consistency were possible.

Third, consistency is not possible. These Clauses have been in effect for seventy years and there still is no method to ensure consistency. *In re Tam*, 808 F.3d at 1342 n.7 ("The PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency.")

Is there a method of ensuring consistency? For example, could there be a list of prohibited words? George Carlin was able to come up with a list, why not the Government? The Government cannot create such a list because many words would be in both the allowed and the prohibited columns. *See* Appendix to this brief, with Carlin's seven words and another list of profane words. Three words are always approved, seven are both approved and refused. Two are never approved. One was approved, then approval withdrawn. Inconsistency is far more common than consistency.

"Marks with salient terms ANAL, ASS, COCK, CUM, FAG, MILF, PENIS, SLUT and WHORE are other examples of marks that were both approved and rejected." *See also* Carpenter & Garner, at 358-59. Other examples of words that are inconsistently evaluated by the PTO include 420 (referring to marijuana), BALLS, BANGERS/Z, BLUEBALL(S), COCAINE, DAMN, DOUCHE, HAND JOB, MASTURBATION, MUFF, NAZI, NOOKIE, POON, SNATCH, and TAINT. In Anne Gilson LaLonde and Jerome Gilson, *Trademarks Laid Bare: Marks That May be Scandalous or Immoral*, 101 Trademark Rptr. 1476, 1478 (2011), they note the term MILF was approved twenty times, and was refused twenty times![9]

The *Brief of* Amicus Curiae *San Francisco Dykes on Bikes*, in *Tam*, at 4-5, describes how even after its mark was registered, the Government continued to refuse the same mark.

Of the thirty-four words mentioned in this Part and the Appendix, only three have been refused consistently. So the PTO's record is about 9% consistent refusal and over 90% always allowed or inconsistent. If the PTO were inconsistent 1% or 5% of the time, it might be able to say it makes an occasional mistake,

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[9] LaLonde and Gilson noted "one must admire the diligent examining attorney who did not raise a scandalousness refusal but instead required the applicant for MILF HUNTER to disclaim the word MILF because '[t]he applicant's adult entertainment will feature MILFs.'" *Id.* at 1482.

although it is still chilling speech. But when the PTO either allows the words or is inconsistent over 90% of the time, the facial invalidity is incontrovertible.

D. Immoral Is Not Capable of Being Defined Without the Government Taking Sides.

Although the Government avoids discussing the Immoral Clause, the Court should not. What is "immoral"? Many persons believe abortion is immoral, while others consider the denial of free access to abortion to be immoral. But there are many registrations on both sides. Alcoholic beverages and smoking are immoral for some. Prostitution is widely regarded as immoral. Yet registrations for all are allowed. WORLD FAMOUS BROTHEL (Reg. 3238218). Some people believe it is immoral to use the Lord's name for commercial purposes. Yet JESUS JAM THE FRUIT OF LIFE for jams (Reg. 328207) and JESUS PEN for pens (Reg. 2509259) were registered. ATHEIST, ATHEISM, DEVIL, and WICCAN are all registered even though anathema to many Christians. Does the PTO decide which religious sects are offensive because other sects consider them to be heretical? What about JEWS FOR JESUS (Reg. 3226872) or JESUS DARWIN (S/N 77/090538)? Those are clearly offensive to some people. GOD DOES NOT HAVE A PENIS for series of books in the field of spirituality was refused. Implicitly the PTO has decided this theological question by refusing the application. The Immoral/Scandalous Clauses not

only infringe Free Speech, but raise other troublesome First Amendment issues.

E. Excessive Discretion Given to Government Employees.

The excessive discretion given to government employees is illustrated by this case. The examining attorney reviewed Brunetti's application multiple times before approving it. The law office manager approved the application. Even publication review was completed without a refusal. It was only afterwards that some unnamed PTO official decided to withdraw the application from publication and return it to the examining attorney with instructions to refuse the application.

Anne Gilson LaLonde and Jerome Gilson noted that PTO determinations are made by "dozens of different individuals of varying political, religious, geographic and family backgrounds." LaLonde and Gilson, *supra*, 1477.

As noted in *Cohen*, "it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." 403 U.S. at 25.

F. The Scandalous Clause Is Over-Inclusive.

The PTO states that: "[T]here is no requirement in Section 2(a) that a mark's vulgar meaning must be the only relevant meaning, or even the most relevant

meaning." TMEP § 1203.01. Humor is no defense: "[W]hether some people would actually find it to be humorous, is immaterial." A "double entendre falls within the proscription of the Scandalous Clause." *Id.* Even if the goods or services are for adults, the mark is refused. *In re Boulevard Entm't, Inc.*, 334 F.3d 1136, 1340 (Fed. Cir. 2003) (1-800-JACK-OFF refused for adult services). Assuming that "public morals," "taste" or shielding children are governmental interests, such interests cannot be advanced in this context.

The Clause is not narrowly drawn.

G. The Lack of a Definition of the Offended Population Compounds the Vagueness.

To counsel's knowledge, *never* has the PTO or any court said what percent of the public must be offended. It is "not necessarily a majority." TMEP § 1203.01. "[W]e recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints. . . ." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

From the case law, it is clear that even a very small percentage of the population is sufficient to refuse registration. *In re Reemstsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (refused registration of SENUSSI as being scandalous to the Senussi order of Islam in Libya and Sudan). The Muslim population of the United States in 1960 was 0.13% of the total population. Houssain Kettani, *Muslim*

Population in the Americas, 1950-2020, 1 INTL. J. ENVIR. SCI. DEV. 20 (2010). Sufism is one of the smaller branches of Islam. And the Senussi order is only one of the dozen orders of Sufism. Whatever the American population of Senussis was in 1959, it was extremely small, likely far less than 0.001%. Yet, possible offense to that small number was enough to refuse registration.

In any event, to give such a minority a veto cannot be consistent with free speech. It is the "heckler's veto."

H. The PTO's Lack of a Clear Evidentiary Standard Adds to Vagueness.

Somehow, the PTO "knows" that a mark is scandalous. In other areas of trademark law, such as proving likelihood of confusion, surveys are frequently used. "Of course, the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under Sec. 1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public." *Mavety*, 33 F.3d at 1374. Despite this explicit invitation, to Brunetti's knowledge, the PTO has *never* relied on any survey as to the offensiveness of a mark.

The PTO is positively hostile to any actual evidence, as this case illustrates. It disregarded Brunetti's evidence of lack of offense (that only one person in more than two decades complained). Instead the PTO mostly relies on dictionaries. And the PTO also relies on information that cannot be dignified with the term

"evidence," such as the *Urban Dictionary*, which is the "dictionary you write." J.A. 67-70. Anonymous persons can post definitions. If the *Urban Dictionary* is valid evidence, then any disgruntled employee could "define" his employer's brand as profane and that trademark would be refused registration. Yet, the *Urban Dictionary* was an important part of the evidence against Brunetti's mark. Pet. App. 7a.

The PTO's policy of relying on unreliable evidence, its lack of any evidence of actual consumer perception, while ignoring the more probative evidence, contributes to the chilling environment created by the PTO's irrational and inconsistent application of the Immoral/Scandalous Clauses.

IV. IMPLICATIONS OF THE COURT'S RULING ON THE IMMORAL/SCANDALOUS CLAUSES

A. Implications if the Clauses Are Held Unconstitutional.

None of the effects imagined by the Government justify ignoring the facial unconstitutionality of the Immoral/Scandalous Clauses.

The Government's focus on "sexually explicit" material misses the point. Obscene marks may be refused registration. Brunetti's mark is not obscene.

Registration of marks does not require that any store carry such products or that anyone purchase such products. The marketplace will not be flooded

with vulgar marks. Retailers will still decide what products are appropriate for their customers.

This case will not affect time/place/manner regulation. Trademark registration is refused for all times/places/manners, for all goods and services, and for all channels of trade.

As discussed in Part III-E, the trademark registration system is not a forum so the decision here will not affect the jurisprudence about forums. For example, cemeteries and buses are still non-public or limited forums.

The Free Speech Clause should not be constrained by the possible embarrassment of the Government or by foreign sensibilities. In any event, Madrid Protocol applications can be based upon U.S. applications (not registrations) and the PTO transmits the Madrid applications long before the Government examines the U.S. application. That foreign governments may refuse similar marks under various treaties, and in fact do so, has no relevance to the Free Speech Clause in this country. Other countries clearly have different understandings of free speech (for example, fascist symbols are prohibited in several European countries even though they constitute protected expression in the United States).

The Court should decline the Government's invitation to speculate about the constitutionality of other Lanham Act provisions, which are not involved here, nor briefed. In any event, this case does not broaden the holding in *Tam* but merely applies it.

B. Implications if the Immoral/Scandalous Clauses Were Constitutional.

If the Clauses are not facially invalid, then the Federal Circuit will have to hear as-applied challenges since the Board refuses to consider them. *Trademark Trial and Appeal Board Manual of Procedure* § 102.01 n.4 (2018) ("no authority to rule on the constitutionality of the Trademark Act on its face or as applied").

Holding the Immoral/Scandalous Clauses constitutional would effectively negate the invalidation of the Disparagement Clause in *Tam*. In the present day, any ethnic slur causes scandal. Any mark now allowed due to the invalidation of the Disparagement Clause would still have to be refused as scandalous if the Immoral/Scandalous Clauses are constitutional.

It also follows that the Government could constitutionally refuse registration of copyright for immoral and scandalous works. Although the constitutional bases for copyright and trademark are different, there are many similarities. Registration for both is optional, although a precondition for effective enforcement by the rights owner. Copyrights range from the purely commercial (advertisements, the 0's and 1's of software) to core speech. Likewise, trademarks range from purely commercial (e.g., EXXON) to core speech such as STOP THE ISLAMISATION OF AMERICA.

The Government offers the distinction that, in copyright, the creative works are the goods, while trademarks are a source identifier. That is a meaningless distinction. The issue is whether speech is being

restricted. It should not matter how speech is restricted: by restricting the goods or restricting the trademark which in turn restricts the goods. It would follow that the Government could constitutionally refuse to register a copyrighted work if the title were offensive.

What else could the Government lawfully prohibit if the Clauses were constitutional? The Government could refuse to register names of vessels, and refuse to recognize names for non-profits or political organizations (it is easy to see that some organization names would be immoral or scandalous to portions of the public). State and local governments could refuse to register names for businesses or organizations, advocating unpopular goals.

Another consequence if the Clauses were constitutional is that state and local governments could refuse to grant building permits, charitable solicitation registrations, business licenses, or sales tax permits on similar grounds. They could effectively prevent unpopular organizations from advancing controversial causes (if the names were scandalous to some portion of the public). It is easy to foresee that some localities will seek to suppress Planned Parenthood, while others may seek to impair the activities of pro-life groups or the Second Amendment Foundation.[10]

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[10] If the Clauses are constitutional, could local governments ban the sale of Brunetti's products or REDSKINS merchandise on the grounds they are scandalous? What about products that are themselves scandalous?

This is no hypothetical concern. *See, e.g.*, *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981) (unconstitutional to require, as condition for grant of a building permit, that a restaurant change its name from SAMBO'S); *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998) (New York alcohol board's rejection of label with frog raising a middle finger held to be an unconstitutional restriction on commercial speech); *Kalman v. Cortes*, 723 F.Supp.2d 766 (E.D. Pa. 2010) (Pennsylvania's refusal to accept I CHOOSE HELL PRODUCTIONS, LLC as an entity name was an unconstitutional viewpoint-based restriction on speech).

Finally, the Immoral/Scandalous Clauses undermine trademark owners' established rights. Under Section 15, 15 U.S.C. § 1065, allegedly immoral or scandalous marks are *always subject* to cancellation. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005) (laches applies, but can be avoided by selecting a petitioner who just turned 18). *See also Brief of* Amicus Curiae *Pro-Football, Inc.* in *Tam* at 29-35.[11]

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[11] What happens if a mark is registered but becomes scandalous because of changing attitudes about, for example, the Confederacy and its leaders, or preferred ethnic names? *E.g.*, ESKIMO PIE (Reg. 4973104); JEFFERSON DAVIS INN (Reg. 4482318), RUNNIN' REBELS (Reg. 1731224) (https://en.wikipedia.org/wiki/Hey_Reb!, last accessed March 15, 2019); SONS OF CONFEDERATE VETERANS 1896 (with Confederate flag) (Reg. 2764268); or WASHINGTON & LEE UNIVERSITY (Reg. 2020928). Even if the registrations themselves cannot be invalidated, the brand owner cannot obtain registrations for new types

V. THE COURT SHOULD RETURN TO THE COMMON LAW RULE AND DISAVOW THE *MARKS* RULE

The *Marks* Rule is logically flawed. It does not provide clear guidance in many cases, including this one. The *Marks* decision is a weak precedent because it was not reasoned and ignored the common law. This Court has found the Rule not "useful."[12]

In recent years, this Court has failed to follow the Rule (that is why Brunetti uses "disavow" rather than "overrule").

As the argument in *Hughes v. United States*, 138 S. Ct. 1765 (2018), illustrated, the Court is aware of the problems created by the Rule, but concerned about what would replace the Rule. Brunetti suggests that the Court should return to the common law rule for *stare decisis*: a majority on the judgment and majority on the reasoning (hereinafter referred to as the Dual-Majority maxim).[13]

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of products, updated versions of the mark, or file again if it failed to renew a registration.

[12] *See Nichols v. United States*, 511 U.S. 738, 746 (1994).

[13] Brunetti proposes Dual-Majority as an unambiguous term for the common law rule for *stare decisis*: majority on the judgment and majority on the reasoning. Note that the term "dual majority" has been used to refer to a majority that includes the reasoning of dissenting opinion. *See, e.g.*, Bryan A. Garner, et al., *The Law of Judicial Precedent* 207 (2016). Only the former meaning, always with initial capitals, is used herein.

A. Under the Common Law, Only Majority Opinions are Precedential.

The common law rule is that, "[i]f all or a majority of the judges concur in the result but differ as to the reasons which lead them to this conclusion, the case is not an authority except upon the general result." Henry Campbell Black, *Handbook on the Law of Judicial Precedents or the Science of Case Law* (1912) at 135-36 (parenthetical omitted).

> "There must be a concurrence of a majority of the judges upon the principles, rules of law, announced in the case, before they can be considered settled by a decision. If the court be equally divided or less than a majority concur in a rule, no one will claim that it has the force of the authority of the court." *City of Dubuque v. Ill. Central R. Co.*, 39 Iowa 56, 80 (1874).

Comment, *Supreme Court No-Clear-Majority Decisions: A Study in Stare Decisis*, 24 CHI. L. REV. 99 (1956), makes an exhaustive analysis of this Court's no-clear-majority cases between 1900 and 1956. A fair summary of the author's conclusions is that no-clear-majority cases were cited and relied upon, but often without consideration of the fact that they were minority opinions. There seems to be little authority pre-*Marks* that minority opinions, *when the precedential value of the minority opinion was actually considered by the citing court*, establish binding precedents.

See also Richard M. Re, *Beyond the Marks* Rule, HARV. L. REV. 6 n.26 (forthcoming 2019) (*available at*

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3090620); Ryan C. Williams, *Questioning* Marks: *Plurality Decisions and Precedential Constraint*, 69 STANFORD L. REV. 795, 806 n.44, 845 n.239 (2017); Mark Alan Thurmon, Note, *When The Court Divides: Reconsidering the Precedential Value of Supreme Court Plurality Decisions*, 42 DUKE L.J. 419 (1992).

B. The *Marks* Rule Is Logically Flawed.

1. If Four Votes Are Not Enough, Then Fewer Votes Must Be Weaker.

The traditional rule is that the decision of an evenly divided court is without precedential effect. In that situation, the Court would remand *per curiam*.

> Nor was our affirmance of the judgment in that case by an equally divided court an authoritative precedent. While it was conclusive and binding upon the parties as respects that controversy, the lack of an agreement by a majority of the Court on the principles of law involved prevents it from being an authoritative determination for other cases. *United States v. Pink*, 315 U.S. 203 (1942) (citations omitted).

If four-to-four is without precedential effect as to the reasoning, how can an opinion joined by only three (or less) members have more weight?

The *Marks* Rule goes even further and can convert the opinion of a single member into a binding precedent. Some courts of appeals concluded that the *Marks* Rule made Justice Sotomayor's opinion in *Freeman v.*

United States, 564 U.S. 522 (2011), *not followed, Hughes, supra*, into a binding precedent.

2. Explicit Disagreement Is Converted into Implied Agreement by *Marks*.

The *Marks* Rule creates an irrefutable presumption that the other members concurring in the judgment impliedly concurred in whichever opinion is narrowest. In effect, *Marks* requires each member to give a blanket proxy to concur in whatever opinion is narrowest when there is no majority opinion. Even if the members in 1977 were willing to grant such implied proxy, it is doubtful that the current members wish to do so.

This is even less logical when the members explicitly refuse to concur. For example, in *Tam*, Justices Alito and Kennedy expressly refused to agree with the other concerning the level of scrutiny. Yet, under *Marks*, one opinion *has to be* the binding precedent.

A rule that converts a failure to agree, or even express disagreement, into implied agreement, is not logical.

C. The *Marks* Rule Is Anti-Majoritarian.

Collective bodies speak through majorities. An unquestioned assumption of American democracy is that it takes a majority to make law. It has never been suggested that, if a majority of a house of Congress agrees some bill should be passed but no single version has an

absolute majority, that the narrowest bill is "passed." As to the election of the President, "The person having the greatest number of votes for President, shall be the President, *if such number be a majority* of the whole number of Electors appointed. . . ." Constitution, Twelfth Amendment (emphasis added).

In the judiciary, the principle of majority rule is so fundamental that it is rarely expressed. Professor Amar writes: "From its first day to the present day, the [Supreme] Court has routinely followed the majority-rule principle without even appearing to give the matter much thought." Akhil Reed Amar, *America's Unwritten Constitution: The Precedents and Principles We Live By* (2012) at 360. He gives four reasons why "simple majority rule as the master norm among the justices. . . ." *Id.* at 357-60.

Since the Judiciary Act of 1869, Act of April 10, 1869, ch. 22, 16 Stat. 44, the number of justices has been set at nine. Courts of appeals decide (except *en banc* hearings) in panels of three. 28 U.S.C. § 46(c). Certain types of constitutional questions are heard in district court by three judges. 28 U.S.C. § 2284(a). Every single state supreme court has an odd number of justices. These are not coincidences; rather they reflect the fundamental assumption that cases should be decided by a majority and an odd number normally ensures a majority.

The exceptions to majority decision-making in this Court are certain powers granted to the Chief Justice,

or individual justices, or for granting certiorari. None of those situations are precedential.

D. The *Marks* Rule Is Not a Rule Because It Does Not Provide Answers.

Which is taller, left or right? Which is narrowest, government speech or strict scrutiny? Is "does not satisfy intermediate scrutiny" narrower than "the standard is exactly heightened scrutiny"? The *Marks* Rule fails as a useful maxim of judicial interpretation because often it is not clear what is "narrowest."

What is "narrowest" can be a function of how the question is presented. An example is Justice Stevens' claim in *Rapanos v. United States*, 547 U.S. 715, 810 n.14 (2006), that less-restrictive on federal jurisdiction was "narrowest." *See United States v. Robertson*, 875 F.3d 1281, 1292 (9th Cir. 2017). Actually, "narrowest" should be less-restrictive on the public (i.e., less federal jurisdiction). But assuming Justice Stevens' interpretation is plausible, the arbitrary phrasing of the question determines which opinion is "narrowest."

The multiple and inconsistent methods of identifying the "narrowest" opinion show another deficiency of the *Marks* Rule. Legal commentators cannot even agree as to how many methods there are.[14]

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[14] It is unclear whether any of the following methods are consistent with the literal language of *Marks*. "When the Supreme Court issues a splintered decision—that is, a decision where a majority of the Court agrees on the result but not the reasoning—the binding holding is the position taken by those Justices 'who

A non-exclusive list of such methods include:

Common Denominator. Garner writes "the prevailing view is that the narrowest grounds are those that, when applied to other cases, would consistently produce results that a majority of the Justices supporting the result in the governing precedent would have reached." Bryan A. Garner, *The Law of Judicial Precedent* (2016) at 200. *See, e.g.*, *King v. Palmer*, 950 F.2d 771, 781 (D.C. Cir. 1991) ("must embody a position implicitly approved by at least five Justices who support the judgment."); *Ass'n of Bituminous Contractors, Inc. v. Apfel*, 156 F.3d 1246, 1254 (D.C. Cir. 1998).

Logical Subset. "Narrowest" can be determined in some situations, such as nested Venn diagrams ("Russian doll" reasoning). But that does not mean A and A-Narrow can be combined. Justice Alito provided an example in the *Hughes* argument: just because someone wants to see a romantic comedy does not mean he also agrees to the "narrowest" choice of seeing a romantic comedy in French. *Hughes* Transcript, 14-15. It is untenable to assume that a member has a second choice. It is even less tenable to assume her second choice is always a narrower version of her first choice. If she has one, it could be a completely different rule. *See generally*, Re, 30-33, Williams, 808-13.

Median Opinion. Is the median opinion the "narrowest"? Law is not about the middle ground, but

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concurred in the judgment[ ] on the narrowest grounds.'" *United States v. Duvall*, 740 F.3d 604, 607-08 (D.C. Cir. 2013) (Kavanaugh, J., concurring on denial of rehearing *en banc*).

about the correct reasoning. While a centrist justice may be an important swing vote, it is illogical to give precedential weight to the median opinion because it is in the middle. Nor is the median opinion always the narrowest. *See generally*, Re, 27-30.

Fifth Vote. The "fifth" vote may not always be "narrowest." Why are the views of the fifth member more important than those of the fourth or the sixth? *See* Williams, 813-17.

Shared Agreement. Professor Ryan Williams proposed a "shared agreement" approach: if some members adopt Rule A and others adopt Rule B, then the holding is that both Rules A and B are required. In some cases that might be valid. But what if a member adopts "A but never B"? Or another member posits "either A or B"? Clearly "both A and B" is not the same. *See* Re, 33-36, Williams, 822-38.

Lesser/Greater Included. In some situations, the Rule is logical if the holding is understood to be a range. In *Freeman* (prior to *Hughes*), the correct precedent should have been "sometimes, but could be always." In *Tam*, a holding of "at least as great as intermediate scrutiny, but possibly as high as heightened scrutiny" might be the rule (assuming that Justice Kennedy implicitly agreed to anything other than "exactly heightened scrutiny").

Brunetti suggests that each of the possible methods are flawed and no universally valid definition is possible.[15]

E. Stare Decisis Does Not Prevent *Marks* from Being Overruled.

1. The *Marks* Rule Was Not Based on Precedent.

Marks was this Court's attempt to deal with the unique problems of the 1970s: fractured Courts on the death penalty and obscenity.[16]

The only basis for the *Marks* Rule was a footnote from *Gregg v. Georgia*, 428 U.S. 153, 169 n.15 (1976), which in its entirety reads:

> Since five Justices wrote separately in support of the judgments in *Furman*, the holding of the Court may be viewed as that position taken by those Members who concurred in the judgments on the narrowest grounds—MR.

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[15] It has been suggested that this Court merely needs to provide further explication of how the *Marks* Rule is to be applied. For example, in *Hughes*, the *Brief* Amicus Curiae *for Agricultural*, proposed four additional rules to make *Marks* useful in the *Freeman* situation. How many more rules to determine how *Marks* applies to *Tam*? How many in other situations? In total, how many rules are needed to apply *Marks* to each type of fractured case? Surely the number is large.

[16] As the Court was unable to agree on a rationale, it decided 31 consecutive obscenity cases by *per curiam* decisions. *Paris Adult Theatre I v. Slaton*, 413 U.S. 49, 82-83 n.8 (1973) (Brennan, J., dissenting).

JUSTICE STEWART and MR. JUSTICE WHITE. *See* n.36, *infra*.

The *Gregg* footnote contains no reasoning or authority. Significantly, the footnote was in an opinion joined by only three justices.

The complete lack of legal authority (other than the minority footnote in *Gregg*) severely undercuts the precedential strength of *Marks*. Nor did the Court acknowledge that it was creating a new rule or discuss any of its implications.

2. The *Marks* Rule Was *Dicta*.

It was agreed by both the Petitioners and the Government in *Marks* that *Memoirs v. Massachusetts*, 383 U.S. 413 (1966), was a sufficient change in the law that it raised *ex post facto* concerns under *Bouie v. City of Columbia*, 378 U.S. 347 (1964) (a new judicial interpretation may constitute an *ex post facto* violation). The Government confessed that instructions based upon *Miller v. California*, 413 U.S. 15 (1973), were erroneous. *See Brief of United States*, 18-34.

The parties failed to correctly identify the question to be decided in *Marks*. Solicitor General Bork framed the question as whether *Roth v. United States*, 354 U.S. 476 (1957) remained binding after *Memoirs*, or in the alternative, there was no obscenity law between *Memoirs* and *Miller*. He concluded that this meant that *Memoirs* was the law. *See Marks*, Transcript (Nov. 2, 1976 at 21-22).

However, the actual question in *Marks* was what jury instructions were to be given on re-trial for conduct occurring through February 1973. The Court correctly concluded that the jury instructions should be based upon *Memoirs*.

> Petitioners, engaged in the dicey business of marketing films subject to possible challenge, had no fair warning that their products might be subjected to the new standards. We have taken special care to insist on fair warning when a statute regulates expression and implicates First Amendment values. *Marks*, 430 U.S. at 195-96.

In this context, the defendants would have understandably read *Memoirs* and assumed that it was the governing law.

But Justice Powell said more. He wrote, "The view of the *Memoirs* plurality therefore constituted the *holding of the Court* and provided the governing standards." *Marks*, 430 U.S. at 194 (emphasis added). Justice Powell's analysis seems doubtful because Chief Justice Burger wrote in *Miller* that:

> But today, for the *first time since Roth* was decided in 1957, a *majority of this Court* has agreed on concrete guidelines to isolate "hard core" pornography from expression protected by the First Amendment. *Id.* at 29 (emphasis added). *See also id.* at 22 ("no majority of the Court has at any given time been able to agree").

The Chief Justice emphasized that *Memoirs* was a plurality and that *Miller* was the first case since *Roth* to establish a majority rationale. Why? Because the Court in *Miller* did not consider *Memoirs* to be a binding precedent.

If there is a *Marks* Rule, it should be only that defendants in obscenity cases can reasonably rely on the opinion printed first. Beyond that, the *Marks* Rule is *dicta*.

F. This Court Does Not Consider the *Marks* Rule to Be Binding.

Among the puzzling facts about the *Marks* Rule is that the Court does not consistently apply it. After *Marks*, this Court continued to apply the principle of majority rule. In *CTS Corp. v. Dynamics Corp. of Am.*, 481 U.S. 69, 81 (1987), the Court wrote, "As the plurality opinion in MITE did not represent the views of a majority of the Court, we are not bound by its reasoning." *CTS* implicitly overruled the *Marks* Rule.

Only in *City of Lakewood v. Plain Dealer Pub. Co.*, 486 U.S. 750, 764 n.9 (1988), did the Court overlook its decision in *CTS* and apply the *Marks* Rule for the first time. Justice White's dissent in *Lakewood* argued that it was illogical to rely on the minority opinion as a binding precedent.

> First, the 'rationale of *Kovacs*' on which the majority relies was not the Court's view at all, but rather, an opinion for a three-Justice plurality. In fact, four other Justices in *Kovacs*

> understood the Court's action in that case in the exact contrary manner. . . . White, J., *dissenting*, *Lakewood*, 486 U.S. at 785 (citations omitted).

The *Marks* Rule has an ambiguous record in this Court. Including *Lakewood*, this Court has expressly relied on the *Marks* Rule five times (*see* Re n.47-48). Once the Court merely noted that the lower court relied on the Rule (*id.* n.49). More frequently, the Court does not rely on the Rule. The Court has cited the Rule four times without applying it (*id.*, cases cited in n.50, and *Hughes*).

This Court has twice explicitly refused to apply the *Marks* Rule. In *Nichols*, 511 U.S. at 745-46, the Court stated:

> "[t]his test is more easily stated than applied to the various opinions supporting the result in [the referenced plurality decision]."

In *Grutter v. Bollinger*, 539 U.S. 306, 325 (2003), the Court quoted *Nichols*:

> "It does not seem 'useful to pursue the *Marks* inquiry to the utmost logical possibility when it has so obviously baffled and divided the lower courts that have considered it.'"[17]

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[17] If the *Marks* Rule had been applied to *Regents of Univ. of Cal. v. Bakke*, 438 U.S. 265 (1978), the Court would have been precluded from considering Justice Powell's views in any subsequent case. Justice Stevens' opinion was the narrowest (surely deciding the statutory issue before reaching the constitutional issue is narrowest). Yet, Justice Powell's views eventually

In summary, this Court does not consistently apply the *Marks* Rule, especially not recently. If a rule is applied sometimes, and sometimes not, it may be a guideline but it is not a binding rule.[18]

1. Third Time Is a Charm: if the *Marks* Rule Is Unhelpful, the Court Should Explicitly Reject It.

The Court could, as suggested in the Government's petition reply brief, "simply revisit[ ] the underlying question addressed in the decision rather than" applying the *Marks* Rule. Reply Brief for Petitioner, page 6 n*. That essentially concedes that the *Marks* Rule has no continuing vitality.

In this case, the Court has to apply *Marks* to *Tam*. The saying is "the third time is the charm." If, at least three times the Court considered *Marks* and concluded the Rule is not useful, then the Court has functionally overruled *Marks*. The Court might as well make its disavowal explicit.

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commanded a majority. Does not this example alone show the danger of taking minority views and converting them into precedents that bind this Court as well as lower courts?

[18] Interestingly, in his *Brief of Law Professors as* Amicus Curiae, in *Hughes*, at 4, 5, Professor Stearns acknowledges the *Marks* Rule is not binding on this Court. However, he asserts that *Marks* remains binding on lower courts. *Stare decisis* is both horizontal and vertical. Obviously, who can overrule a precedent, applies only horizontally.

The *Brief of Professor Richard M. Re as* Amicus Curiae in *Hughes*, at 13-14, deserves quotation:

> The *Marks* rule plays a significant and growing role in legal practice, yet there is a powerful case for abandoning it. . . . [W]hen governing decisions are unworkable or are badly reasoned, this Court has never felt constrained to follow precedent." *Payne*, 501 U.S. at 827-28. And because the *Marks* rule "is judge made and implicates an important matter involving internal Judicial Branch operations," the responsibility to take corrective action lies with this Court. *Pearson v. Callahan*, 555 U.S. 223, 233-34 (2009).

2. The Court Should Return to the Common Law Rule of Dual-Majority.

In place of the *Marks* Rule, the Court should return to the bright-line common-law maxim of Dual-Majority.

The Dual-Majority maxim will be beneficial for all the reasons the *Marks* Rule is deleterious. This Court will not be bound by horizontal *stare decisis* to follow the views of a minority in a prior case. Nor will lower courts feel compelled under the doctrine of vertical *stare decisis* to follow minority opinions.[19]

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[19] Approximately 400 court of appeals decisions have attempted to apply the *Marks* Rule to about 100 decisions of this Court, with highly divergent results and reasoning. *See* Re, *supra*, at 10-14.

There will be fewer precedential opinions if this Court returns to the common law maxim of Dual-Majority. Fewer precedents, if that means no binding precedents based upon minority opinions, is a good thing.

Lower courts will still be required to "run the facts through the opinions" of the fractured decision and see if there is an applicable precedent based upon the judgment.

> "[T]he necessary logical corollary to *Marks* is that lower courts should still strive to decide the case before them in a way consistent with how the Supreme Court's opinions in the relevant precedent would resolve the current case." *United States v. Duvall*, 740 F.3d 604, 611 (Kavanaugh, J., concurring on denial of petition for rehearing *en banc*).

Another corollary to the Dual-Majority maxim is a presumption against implied agreement. When a concurring or dissenting justice agrees in part with the rationales of other justices, she has the ability to say so explicitly. Members take great care in writing their opinions. In the absence of such explicit agreement, it should not be presumed that a justice forgot to express her agreement with other opinions.

It is best to disavow the *Marks* Rule completely with immediate effect because this Court has not consistently applied it. Disavowal is unlikely to adversely affect settled expectations (unlike rules affecting property interests), especially since the problems with the

Rule prevent settled expectations. Or the Court could apply the disavowal only prospectively, or even prospectively only to fractured cases decided after this case.

The Court must either apply the *Marks* Rule or ignore it. The Dual-Majority maxim is clearly preferable to attempting to apply the often indeterminate *Marks* Rule to reach sometimes illogical results.

CONCLUSION

Brunetti urges the Court to affirm the Court of Appeals by finding the Immoral/Scandalous Clauses facially unconstitutional. In doing so, Brunetti urges this Court to explicitly adopt a level of scrutiny that is strict. Should it be necessary to reach the issue, the Immoral/Scandalous Clauses are unconstitutionally vague.

The Court should also disavow the *Marks* Rule and return to the common law maxim of the Dual-Majority: majority on the judgment and majority on the rationale.

Respectfully submitted,

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Appendix

PTO's Examination of words in George Carlin's *Seven Filthy Words*[1] and on a list of Profane Words[2]

Applications **Registered** by PTO	Applications **Refused** by PTO
ASS or ASSHOLE	
ASS – registered over 200 times **AHOLES** – 5591208	**ASSHOLE** – 77/485121 **DON'T BE AN AHOLE!** – 86/570406 **A-HOLE PATROL** – 78/951377 **THE COMPLETE A**HOLE'S GUIDE TO. . . .** – 76/351811 *refusal affirmed*, T.T.A.B., January 4, 2005
BASTARD	
LANKY BASTARD – 5679769 **CRAFTY BASTARDS** – 5683491 **DIRTY BASTARDS** – 5497140 **ARROGANT BASTARD** – 2283904	

[1] Carlin's *Seven Filthy Words*: shit, piss, fuck, cunt, cocksucker, motherfucker, tits.

[2] This list was the highest result for "profane words" on Google: https://simple.wikipedia.org/wiki/Profanity (last accessed March 15, 2019).

BITCH	
THE FUNKY BITCH – 5686027; 5685985 **SHINY BITCHES** – 5670238 **BITCH PERFECT** – 5694730 **DIVINE BITCHES** – 3870498 **RICH BITCH** – 3117353	
COCK	
PHAT COCK – 5687273 **BIG COCK OWNER-SHIP CLUB** – 4869291 **I BRAKE FOR COCK!** – 5677097 **FAT COQ** – 4112430	**FAT COCK BEER** – 85/253332 **KING COCK** – 86/500922
COCKSUCKER	
COCKSUCKER – Approved, published, and then withdrawn from publication – 75/942851	
CUNT	
	CUNT – 77/048672
DICK	
DICK – 4652273; 4975914 **SMALL TOWN DICKS** – 5464581 **DICK DANGLER** – 4397617	**PHATDIX.COM** – 86/577413 **GET OFF MY DICK** – 88/101325

FUCK	
FAUQ-YEAH!! – 5282969 **WTF WORK?** – 4332574 **SAUCY AF** – 5699181 (AF refers to "*as fuck*") **WTF WHERE'S THE FOOD TRUCK** – 5642124 Note: search of the PTO database for "fuck" brings up the above four marks. **F'D UP** – 4495813 **FCUK** – 2920270; 2520614; 3028227; 4167152; 5301912 **THE F WORD** – 3116416 **PHUC** – 4354653	**FUCT** (appellant herein) – 85/310960 **FUCK CANCER** – 86/290011
MOTHERFUCKER	
	BAD MOTHER FUCKER – 79/031185
PISS	
SATAN'S PISS – 5233724 **DONKEY PISS** – 4113159 **PISS OFF** – 2958203	
PUSSY	
PUSSY NATURAL ENERGY – 4254281 **RICH PU$$Y** – 5307001 **PUSSY** – 4120676	**PUSSYWEAR** – 75/743995 **PU$$Y CONTROL** – 85/878245 **PUSSY POWER** – 77/387207

PUSSY POWER REVOLUTION – 4507246[3] **MY PUSSY LOVES YOU** – 5219014	**INFAMOUS PUSSY** – 87/448939 **PUSSY RIOT** – 87/152598
SHIT	
$#*! THE BED – 5192367 **$#*! MY DAD SAYS** – 4142745 **SCHIIT** – 5443096 **WHERE'S MY FREE SHIT** – 5292288	**APE $#!+** – 85/611740 **NO $#!+** 85855449 (*In re Jones*, 2013 T.T.A.B. LEXIS 615 (T.T.A.B. 2013) (not precedential)) **NO-SHIT** – 77/913273 **S#!TS & GIGGLES ELK POOP ACCESSORIES** – 85/542023
TITS	
TIT – 5056984 **TIT-PIK** – 4610032 **TITS** – 3120205	**TITS OUT FOR BAMBI** – 87/272072 **TITS FIRST** – 88/178580 **DON'T DRINK MILK FROM A WITCH'S TIT** – 86/699562

[3] Another example of PTO inconsistency is PUSSY POWER. The mark was okay in 2007, scandalous in 2009, okay again in 2014, and deemed scandalous again in 2017 and 2018. *See* POWER PUSSY (78/852737, allowed 02/13/2007); PUSSY POWER (scandalous per office action 02/15/2009); PUSSY POWER REVOLUTION (registered 04/01/2014); PUSSY POWER (87/520058, scandalous per office action 12/15/2017); PUSSY POWER (88/163730, scandalous per office action 12/14/2018).